REMARKS

This is a full and timely response to the non-final Official Action mailed **February 17, 2004** (Paper No. 2). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 33 and 51 have been amended. Additionally, new claims 52-58 have been added. Claims 34-36 have been cancelled herein. Claims 1-32 were cancelled previously. Thus, claims 33 and 37-58 are currently pending for the Examiner's consideration.

Prior Art Rejections:

Independent claim 33 and claims 36-38, 41, 42 and 51 were rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Abstract 03-284948, inventor: Miyake Nobataka, ("Miyake"). Claim 33 has been amended herein to include the recitations of claims 34 and 35. Claim 35 was rejected as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of Miyake, U.S. Patent No. 6,354,700 to Roth ("Roth") and U.S. Patent No. 5,723,251 to Moser ("Moser"). This rejection is respectfully traversed for at least the following reason.

As amended, claim 33 recites:

> A method of printing with an inkjet printing system, said method comprising:
> providing a supply of liquid ink comprising a carrier fluid;
> using said ink, printing an image with an inkjet print head on a transfer member that is adjacent to said print head and moveable with respect to said print head;
> evaporating some of said carrier fluid from said image as said transfer member moves between said inkjet print head and a position at which said image is transferred from said transfer member to a sheet of print medium; and
> transferring said printed image from said transfer member to a sheet of print medium;

wherein said transfer member is a transfer belt and said method further comprises absorbing carrier fluid from ink of said image with said transfer belt. (emphasis added).

In the rejection, Moser is cited for the teachings of a belt that absorbs carrier fluid. However, the teachings of Miyake and Moser are incompatible in this regard and cannot be combined as proposed.

Miyake expressly teaches that the transfer member (e.g., the drum 2) is not to absorb any fluid. In fact, Miyake states that "liquid droplets discharged and recorded do not penetrate into a film due to the water-repellent effect of a PET film on the drum." (Miyake, Constitution). Consequently, one of skill in the art would not have been lead to combine the teachings of Miyake with those of Moser as suggested by the Office Action.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.01. For at least these reasons, the rejection of claim 35 should be reconsidered and withdrawn.

The Office Action also rejected independent claim 44 based on the cited prior art. However, the language of the Action is confused, making it difficult to understand the exact nature of the rejection against claim 44. Specifically, Section 6 of the Action states that claims 44, 46, 49 and 50 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of U.S. Patent No. 6,354,700 to Roth ("Roth") and U.S. Patent No.

5,365,261 to Ozawa ("Ozawa"). However, the Action fails to establish *prima facie* obviousness in that it does not establish any motivation or suggesting for modifying Roth with the teachings of Ozawa.

In fact, the Office Action does not actually discuss the Roth reference. Rather, the Action proposes a combination of the teachings of Roth and Ozawa, but then discusses Japanese Patent Abstract 03-284948 to Miyake ("Miyake") and does not mention Roth. Thus, the Action clearly fails to make out a *prima facie* case of obviousness against claim 44 and its dependent claims.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. Therefore, because there is no reason of record to combine the teachings of Roth and Ozawa as proposed, the rejection of claims 44-50 should be reconsidered and withdrawn.

Double Patenting:

The Action also makes two separate double patenting rejections.

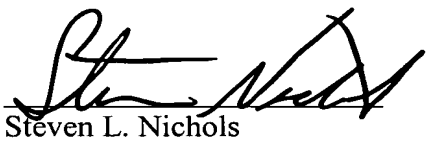
The first is a provisional rejection under 35 U.S.C. § 101 based on claims 33-51 of U.S. Patent Application No. 10/611,738. Applicant, however, intends to prosecute the present application in favor of Application No. 10/611,738. In fact, Applicant expects to abandon Application No. 10/611,738. Therefore, this provisional rejection should be held in abeyance and the present application should be allowed to proceed to issuance over Application No. 10/611,738.

The second double patenting rejection is an obviousness-type double patenting rejection based on claims 1-10 of U.S. Patent No. 6,639,527. Accordingly, a terminal disclaimer is filed herewith to associate the present application with U.S. Patent No. 6,639,527. This should clearly over come the second double patenting rejection and notice to that effect is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 6 May 2004



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